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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,571	07/31/1998	PAILY VARGHESE	COMP:0016	1413

1200 7590 05/06/2003

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EXAMINER

TRAN, KHOA H

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/127,571	VARGHESE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Khoa Tran	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-51 is/are pending in the application.
- 4a) Of the above claim(s) 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 49-51 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/17/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### ***Drawings***

The proposed drawings correction and/or the proposed substitute sheets of drawings, filed on February 17, 2003 have not been approved because the lead line of reference numeral "66" is not appear in a dashed line and connected to the element to which it refers. Note Figure 7, the front bracket showed in a dashed line behind a front flange, thus the lead line of reference 66 should be in a dashed line as well in order to reference the hidden front bracket. Correction is required.

A proposed drawing correction or corrected drawings are required in reply to the Office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 36-38, 43, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Good et al. ('256). Good et al. ('256) disclose a mounting system for a computer component rack comprising:

a support member (42a, 42b) comprising

a support (52), at least partially interposed, between a pair of front (14a) and back (14b) vertical rack members and recessed outwardly, forming a support member recess (note a support member recess is formed between respective pair of outwardly

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bend flange members 54a and 54b, and 56, and 58) at least partially interposed between the pair of vertical rack members when the support member is attached to the pair of vertical rack members;

a telescoping rail assembly (44, 46, 48 and 50), see column 5, lines 11-14, mountable to the support rail (52) within the support member recess, such that a portion of the telescoping rail assembly is recessed outwardly within the support member recess between the bend flange members, see Figure 2;

the telescoping rail assembly has a first telescoping rail (48) mounted to a recess formed in a side near the bottom (30) of a computer component enclosure (22) such that the computer component enclosure can slide in and out of the vertical rack members and a second telescoping slide rail (44) mounted to the first telescoping slide rail and mounted to the support rail (52) within the support member recess; wherein the second telescoping rail cannot extend beyond the pair of vertical rack members.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, 39, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al. ('256) as applied to claims 33, 36-38, 43, and 44 above, and further in view of Fall ('690). Fall ('690) teaches the rail assembly comprising a first

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rail that has an outer rail (47) and an inner rail (58) mounted to a second rail that has an outer rail (40) and an inner rail (55), wherein the first outer rail (47) is fixedly mounted to the second inner rail (55) and the inner rails (55 and 58) are movable along the fixed outer rails (40 and 47). See Figure 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the rail assembly of Good et al. ('256) with the rail assembly as taught by Fall ('690) in order to have the rail assembly that has at least one channel members constitute a part of the intermediate element of the slide structure to improve the resistance to the vertical bending stress. Further, it should be noted that the second telescoping rail (40) when mounted to the support rail (44), it would prevent the second outer rail from extending beyond the pair of the vertical rack members because the second outer rail is fixed to the support rail.

Claims 40-42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al. ('256) in view of Fall ('690) as applied to claims 33-39 and 43-46 above, and further in view of Fall et al. ('505). Fall et al. ('505) teach the support rail (10) that is twice the size or twice the height of the rail assemblies (12), which are mountable to the support rail upper and lower portions. See Figure 1. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the modified mounting system of Good et al. ('256) with the provision of the support rail that is twice the size or twice the height of the rail assembly as taught by Fall et al. ('505) in order to provide a choice of mounting the rail assembly on either the upper portion or the lower portion on each side of the support rail so that to suitable the desire arrangement of the computer component enclosure mounts thereon the rack.

***R s p o n s   t o   A m e n d m e n t***

Applicants' arguments with respect to claims 33-48 have been considered but are moot in view of the new ground of rejection.

With respect to claims 35 and 46, applicants' explanation to which rail cannot extend beyond the mounting flange has overcome the drawings objection and the rejection under 35 U.S.C. 112, first paragraph.

With respect to applicants' allegations that Good et al. fail to teach the claimed subject matter of "the support recess in applicants' apparatus is at least partially interposed between the front and rear vertical rack members", as illustrated by Figures 7 and 9, the examiner respectfully disagrees. It should be noted that the patentability of the claimed subject matter is based largely in part on the language of the claims. Applicants claimed the support rail (50 or 46) forming a support member recess fail to draw a distinction to which part on the support rail is being considered "a support member recess" since there are several recesses forming on the support rail. Accordingly, the claimed language set forth in the claim does not draw a distinct to which part on the support rail is considered a support member recess, thus the support member recess of applicants appears to "read on" the support rail member of Good et al. ('256) because the support member recess of good et al. ('256) is formed between the respective pair of flange members (52 and 58, and 54a and 54b) that are outwardly bend, see Figures 2 and 3. If applicants are still disagree with the rejection that Good et al. ('256) do not have the support recess as applicants' claimed, applicants are encouraged to amend the claim to better reflect what applicants intend to claim as the

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support recess in order to avoid the claim from reading on the prior art of Good et al. ('256).

With respect to applicants' arguments to the rejection of Good et al. ('256) in view of Fall ('690), it should be noted that obviousness cannot be established by attacking references individually when a rejection is based on a combination of references. Further, there is no requirement for a secondary reference to meet every limitation of the claim before it can be utilized. It should be noted that Fall ('690) teaches a well-known per se of a rail assembly having an outer and an inner rail that use to support a drawer from a cabinet or frame for sliding movement. Thus, it would have been obvious to one of ordinary skill in the art to modify the telescoping rail of Good et al. ('256) with the provision of the rail assembly of Fall ('690) in order to have the rail assembly that has at least one channel members constitute a part of the intermediate element of the slide structure to improve the resistance to the vertical bending stress. Further, it has long been established by case law that it is well-within the level skill in the art to utilize known features of the art for the purpose for which they are known and substitute one rail assembly for another rail assembly is well-within the purview of one of ordinary skill in the art.

With respect to claims 40-42 and 47-48, applicants do not provide any argument to the rejection, thus the claims fail to overcome the Prima Facie Case of Obviousness.

The new grounds of rejection were necessitated by applicants' amendment because the deletion of "a pair of attachment members attachable to the pair of vertical rack members; and", see claims 33 and 43, lines 6-7, and the insertion of "at least

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partially interposed", see claims 33 and 43, lines 8 and 10 that cause that cause the interpretation of the claim to change.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 8:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the  
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\_\_\_\_\_

(Signature)

Furthermore, please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile

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will only cause further unnecessary delays in the processing of your application;  
duplicate responses where fees are charged to a deposit account may result in those  
fees being charged twice.

Khoa Tran  
April 29, 2003

A handwritten signature in black ink, reading "Daniel P. Stodola". The signature is written in a cursive, flowing style.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600